

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Koji ICHIKAWA

Application No.: 10/669,608

Confirmation No.: 5671

Filed: September 25, 2003

Art Unit: 2446

For: IMAGE-CORRECTION PROCESSING
APPARATUS AND PROGRAM

Examiner: J. E. Avellino

**REQUEST FOR REVIEW BY SUPERVISORY PRIMARY EXAMINER
PURSUANT TO MPEP 707.02**

AF Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Madam:

Section 707.02 of the MPEP provides:

The supervisory patent examiners should impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them.

The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent Office action with a view to finally concluding its prosecution.

Any application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort should be made to terminate its prosecution. In order to accomplish this result, the application is to be considered "special" by the examiner (emphasis added).

The present Office Action is the fourth Office Action to be mailed in this application, and this application has been pending for over five years. The examiner has

failed to respond to previously presented arguments as to deficiencies in the asserted combination of Spyglass Prism and Fox from the After-Final Reply dated March 6, 2008 and from the RCE Amendment filed April 8, 2008 even though this reliance on Spyglass and Fox has not changed since these filings. The examiner has further failed to respond to the new arguments pointing out the deficiencies in the asserted combination of Spyglass Prism and Fox appearing at the bottom of page 9, to the top of page 11 of the last response filed August 4, 2008, as well as the arguments directed to the deficiencies of Himmel that appear in the two full paragraphs on page 13 of this response filed August 4, 2008.

In this regard, the outstanding Action simply declares the previous arguments moot because a new reference to Marmar has been added to the existing combination of Spyglass Prism, Fox, and Himmel that in no way changes the previous erroneous reliance on these references or the failure to treat the present “means-plus-function” limitations of the claims as the cited case law requires. See the paragraph bridging pages 10 and 11 of the last response noting the relevant case law and court required treatment of such “means-plus-function” claim limitations as follows:

It is by now well established that the first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 [58 USPQ2d 1801, 1806] (Fed. Cir. 2001). It is further well established that the PTO must demonstrate that the references relied upon teach the same function that is claimed. *See Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997).

The reasons that the PTO believes that the case law can be ignored are important as they form the rationale behind the rejection and 35 U.S.C. § 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed. Clearly, setting forth all relied on rationales to support the rejection in a way that gives the applicant a fair opportunity to respond is mandated by the statute and not something that is left to the discretion of the PTO.

Also, the outstanding Action improperly relies on MPEP § 2144.03 as providing the PTO authority to ignore arguments traversing the improper use of official notice. However, MPEP § 2144.03 specifically recognizes that the case law (e.g., *In re Ahlert*,

424 F.2d 1088, 165 USPQ 418, (CCPA 1970) noted in MPEP §2144.03) establishes that if official notice is used at all, it can only be used to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing to support a particular ground for rejection. This section specifically points out that such notice ("well known") is not to be used as to "assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art" because such technical facts "must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21."

The Examiner cannot use MPEP §2144.03 to create an admission as admissions are statements against interest and they must be expressly set forth. It was for this reason that the last response noted the following at pages 11-12 as follows:

It is noted that the paragraph bridging pages 8 and 9 of the outstanding Action misinterprets MPEP §2144.03 as establishing a legal principle. However, the MPEP does not have the force of law, and is entitled to legal effect only as to representing the PTO interpretation of statutes and regulation. See *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1180 n.10, 33 USPQ2d 1823, 1828 n.10 (Fed. Cir. 1995). Moreover, this section itself notes the controlling decision of *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697-98 (Fed. Cir. 2001) as establishing that the PTO can never rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection is based. Nothing in the PTO improper interpretation of *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943) can overrule *Zurko* by creating a PTO interpreted rule of admitted prior art. In this last respect the court in *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943) only noted that they would not consider the argument challenging the PTO position as it had not been made before the PTO, not that they considered there to be any admitted prior art because the Applicant did not challenge the assertion at the very first opportunity in the reply to the Action which made the assertion.

Also, nothing in *Chevenard* supports the apparent PTO interpretation that anything more than a demand for evidence is required to put the PTO to its duty of supplying evidence under the applicable law, not mere opinion and unsupported conclusions. See *In re Lee*, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002), as follows:

In finding relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint [that

of the person of ordinary skill in the art to which the subject matter pertains]. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administration procedure or effective judicial review.

In accordance with the above noted legal precedent, it is demanded that the PTO carry its burden under the Administrative Procedure Act and produce the substantial evidence required thereby as to the mere conclusions of knowledge in the art offered as to the rejection of claim 1 based on asserted but unproven "programming choice" at page 5, lines 12-13, of the outstanding Action; the rejection of claim 12 based on the mere conclusion offered at page 7 of the outstanding Action as to a cellular network bandwidth being lower than that of an undefined wired network; and assertions as to cellular phones and JPEG made at page 8 of the outstanding Action relative to Claims 13 and 14.

Accordingly, the SPE is called upon to instruct the examiner to follow the above noted case law and the Administrative Procedure Act and produce the substantial evidence required thereby instead of refusing to cite the supporting evidence that must be "capable of instant and unquestionable demonstration as being well-known" under MPEP 2144.03.

Not only has the examiner clearly misused "Official Notice" as an alternative to the required production of substantial evidence as to claims 12-14, he has again offered his completely unsupported opinion that even though Himmel does not disclose that the query is done in response to receiving an image, the examiner's conclusion that one skilled in the art would easily make this modification as a simple programming choice. This unsupported conclusion lacking the required showing of substantial evidence is prohibited by the above noted case law and the Administrative Procedure Act. It is also clearly improper for the reasons noted at the bottom of page 13 of the last response.

Accordingly, the SPE is called upon to further instruct the examiner to follow the above noted case law and the Administrative Procedure Act and produce substantial evidence in place of the mere allegation of "a simple programming choice."

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: January 30, 2009

Respectfully submitted,



By

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